UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,508	09/15/2003	Brandt Gerard Cordelli	JCORD-1	7398

23599 7590 10/03/2008

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER	
EVANS, KIMBERLY L	
ART UNIT	PAPER NUMBER
3629	

MAIL DATE	DELIVERY MODE
10/03/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/661,508	CORDELLI, BRANDT GERARD	
	Examiner	Art Unit	
	KIMBERLY EVANS	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-38* is/are rejected.

7)☒ Claim(s) *9-16, 19, 20, 23, 24, 26, 28, 30, 32, 35, and 36* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on September 15, 2003.
2. Claims 1-38 are currently pending and have been examined.

Specification

3. The disclosure is objected to because it appears to include and refer to drawings which are not labeled or numbered. The drawings must show every feature of the invention specified in the claims. The twelve (12) pages identified in the specification should be identified separately as drawings and/or figures. They are improperly placed in the specification. The specification should be amended so that it does not include the unlabeled (twelve) pages. In addition, drawings (separate from the specification) with descriptive text labels, titles, and properly numbered should be provided. Correction is required. See MPEP 608.01(b).

Claim Rejections - 35 USC § 101

4. The following is a quotation of the first paragraph of 35 U.S.C. 101:
   a. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

5. Claim 1 and the dependent claims are rejected under U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1, limitation 1 recites "tangible medium setting for a multiplicity of categories" rendering the claim non-statutory in accordance with U.S.C.101. Examples of subject matter not patentable under the statue: Printed Matter, for example a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller,* 418 F.2d 11392, 164 USP" 46 (C CPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). See MPEP 706.03(a). The supporting dependent claims do not remedy this flaw and are also rejected.

6. Claim 2, and the dependent claims are rejected under U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 2, limitation 1 recites "making a determination", and limitation 2 recites "human or computer action, instructions" it appears that the method of claim 2 comprises nothing more than software modules (i.e. library, framework components, code, program) rendering the claim non-statutory in accordance with U.S.C.101. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. Claims 1-38 fail to meet the above requirements because they are not tied to another statutory class of invention. Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post- solution activity are not enough to

convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. The supporting dependent claims do not remedy this flaw and are also rejected.

7. Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The aforementioned claims are directed toward providing information in relation to an electronic communication device via a data signal. However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In their broadest reasonable interpretation and in light of the specification, claims 1-38 as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, these claims are not eligible for patent protection.

8. Claims 1-38 do not qualify as a statutory process since they recite purely mental steps. To qualify as a § 101 statutory process, the claim should positively recite the other statutory class (thing or product) to which it is tied. For example, by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. The claim language in the aforementioned claims does not include the required tie or transformation which would provide the application of the test to the claims to reach the conclusion of nonstatutory subject matter.

9. Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed component is interpreted as being software per se; software does not fall within a statutory category of patentability. The dependent claims do not remedy this flaw and are also rejected.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

    A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

    a. Determining the scope and contents of the prior art.
    b. Ascertaining the differences between the prior art and the claims at issue.
    c. Resolving the level of ordinary skill in the pertinent art.
    d. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-4, 27, 33 and 34 are rejected as being unpatentable over Beinat et al., US Patent No US 7,337,121 B1 in view of National Underwriter, AIG tackles claims management, April 12, 1999, herein referred to as "AIG".

13. With respect to Claims 1-4,

    Beinat discloses the following limitations:

- *a tangible medium setting forth a multiplicity of categories of circumstances relevant to analyzing the claim which either apply or do not apply to the claim,*
- *making a determination whether each of a multiplicity of categories of circumstances relevant to analyzing the claim either apply or do not apply to the claim and indicating such in a tangible medium setting forth the categories,*

  (see at least column 4, lines 32-37: "…To analyze a particular claimant's case, the engine retrieves data from database 12 that relates to a particular claimant's injuries or other conditions. That is, once the user has indicated through the Case Notebook the conditions that apply to the claimant…"; column 6, lines 6-17: "…The Case Notebook also receives medical details specific to the claimant. These are entered as codes (hereinafter referred to as ICD9 codes) found in revision 9 of the International Classification of Diseases--Clinical Modification. There are currently between 12,000 and 14,000 ICD9 codes…a user simply enters all ICD9 codes that apply to that particular claimant as provided by medical reports…")
- *human-or computer-executable instructions for determining, from the number of categories found to apply, and optionally also from their relative importance,*
- *based on the determinations of how many categories apply, and optionally also from their relative importance*

  (see at least column 2, lines 5-9: "…For each medical condition of a plurality of predetermined medical conditions, a severity value is provided that describes the impact of the medical condition on at least one body part. One or more of the predetermined medical conditions that affect the person are identified. The severity values for the identified medical conditions are combined to a combined severity value…"; Figure 1, column 3, lines 30-50: "…Common law liability depends on the severity of the claimant's injuries…The model…is comprised of an engine 10, database 12, and three front-end modules identified as "Task Wizard" 14, "Case Notebook" 16 and "Tuning Wizard" 17…."; column 4, lines 46-50: "…each medical condition is associated with a severity level that

can be translated into one or more common law damages categories…"; column 35, lines 48-52: "…SQL server database 12 (FIG. 1) includes a table that assigns a severity to each ICD9 code. The severities used for one preferred embodiment of the present invention are provided in column 8 of the Medical Body Parts.zip file in the electronic appendices. Thus, each medical condition represented by the ICD9 codes has its own severity value…")

Beinat discloses all of the above limitations, Beinat does not disclose the following limitations but AIG however as shown discloses:

- *whether the claim should be referred to a higher review level.*
- *executing, by human or computer action, instructions provided on or with the tangible medium to determine whether the claim should be referred to a higher review level.*
- *number of categories found to apply, whether the claim should be referred to a higher review level are executed by a computer.*
- *the instructions for determining whether the claim should be referred to a higher review level are executed by a computer*

  (see at least paragraph 4: "…IDM uses a telephonic case management system that profiles incoming claims and enables case managers to identify those most in need of case management. This helps reduce lost days and achieves optimum medical outcomes…"; paragraph 9: "…the IDM program uses a single-source 800 number to report claims, a single customer service and medical management team, single dispute resolution, and cross-and duplicate-claims monitoring…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat with the Integrated Disability Management (IDM), claims management strategies of AIG because this would help provide early intervention, thereby minimizing costs and provide real-time claims information. This would offer a more efficient process for management of liability insurance claims.

14. With respect to Claims 33,

Beinat and AIG disclose all of the above limitations, Beinat further discloses,

- *the tangible medium contains at least one data entry area for information identifying the claim.* (see at least Figure 16, column 4, lines 63-65: "...the user enters information about the claimant through Case Notebook 16. Injury, treatment, and complication information is entered for a particular claimant and triggers the engine to retrieve certain profiles stored in database 12...")

15. Claims 5-8, 25, 27, 29, 31, and 34, 37, 38 are rejected as being unpatentable over Beinat et al., US Patent No US 7,337,121 B1 in view of National Underwriter, AIG tackles claims management, April 12, 1999, herein referred to as "AIG", in further view of DiRienzo US Patent No 7,346,768 B2.

16. With respect to Claims 5 and 6,

Beinat and AIG disclose all of the above limitations. The combination of Beinat and AIG does not disclose the following limitations, but DiRienzo however as shown discloses,

- *whether the claim should be automatically referred to a higher review level without further analysis or referred to a higher review level with qualification of an additional analysis.* (see at least Figure 3A, column 12, lines 32-38: "...The method starts at step S101 with the service provider's diagnosis that a costly procedure is necessary. It is then determined that the patient needs prior approval from his insurance company. During step S102, the patient is provided with an explanation of the procedure and a cost estimate for that procedure. The service provider and the patient then prepare the needed PAC Application...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat and the Integrated Disability Management (IDM), claims management strategies of AIG with the Attachment Integrated Claim (AIC) application

system of DiRienzo because this would allow the insurance company to review the claim (text and attachment), hence, provide early intervention, thereby minimizing costs and provide real-time claims information.

17. With respect to Claims 7 and 8,

Bienet, AIG and DiRienzo disclose all of the above limitations, Bienet further discloses:

- *the tangible medium contains multiple categories in a primarily prominent portion of the medium from which the determination of automatic referral is made and multiple categories in a secondarily prominent portion, the determination of qualified referral being made from the categories in both such portions.* (see at least column 4, lines 32-38: "...each medical condition is associated with a severity level that can be translated into one or more common law damages categories. Thus, the model can predict common law liability when actual or potential claims fall outside a workers' compensation ..."; see at least Figures 2A and 2B, column 5, lines 30-each medical condition is associated with a severity level that can be translated into one or more common law damages categories. Thus, the model can predict common law liability when actual or potential claims fall outside a workers' compensation...")

18. With respect to Claims 25, and 29,

Bienet, AIG and DiRienzo disclose all of the above limitations, DiRienzo further discloses:

- *whether the claim should be referred to a higher review level are based on a weighting system whereby each category is assigned a particular weighting and a certain threshold of the sum of weightings of the total categories or a sub-set of categories found applicable is met.*

  (see at least Figure 18, Table 20, column 52, lines 16-25: "...Determining the percentage of the total severity contributed by each body part, the arm, left elbow and left forearm contribute, in decimal format, 0.004, 0.523 and 0.473, respectively, of the whole. Each body part's contribution to the total severity is projected onto its position vector as defined by its

coordinates. That is, the X, Y and Z components for each body part are multiplied by the body part's severity contribution, resulting in the weighted body part coordinates…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat and the Integrated Disability Management (IDM), claims management strategies of AIG with the Attachment Integrated Claim (AIC) application system of DiRienzo because this would allow the insurance company to more efficiently evaluate liability claims.

19. With respect to Claims 27 and 31,

Bienet, AIG and DiRienzo disclose all of the above limitations, AIG further discloses,

- *claim should be referred to a higher review level are executed by a computer* (see at least paragraph 4: "…IDM uses a telephonic case management system that profiles incoming claims and enables case managers to identify those most in need of case management. This helps reduce lost days and achieves optimum medical outcomes…"; paragraph 9: "…the IDM program uses a single-source 800 number to report claims, a single customer service and medical management team, single dispute resolution, and cross-and duplicate-claims monitoring…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat with the Integrated Disability Management (IDM), claims management strategies of AIG because this would help provide early intervention, thereby minimizing costs and provide real-time claims information. This would offer a more efficient process for management of liability insurance claims.

20. With respect to Claim 34,

Bienet, AIG and DiRienzo disclose all of the above limitations, Bienet further discloses:

- *the tangible medium contains at least one data entry area for information identifying the claim.* (see at least Figure 16, column 4, lines 63-65: "…the user enters information about the

claimant through Case Notebook 16. Injury, treatment, and complication information is entered for a particular claimant and triggers the engine to retrieve certain profiles stored in database 12...")

21. With respect to Claims 37 and 38,

Bienet, AIG and DiRienzo disclose all of the above limitations, DiRienzo further discloses:

- *compiling data from the tangible media prepared under the system for a multiplicity of claims and conducting a trend analysis on one or more aspects thereof.* (see at least Figure 16,column 35, lines 43-47: "...a user may modify the variables to reflect changes in liability trends, or to allow the model's use in a different area, without requiring modification of each severity value...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat and the Integrated Disability Management (IDM), claims management strategies of AIG with the Attachment Integrated Claim (AIC) application system of DiRienzo because this would allow the insurance company to more efficiently evaluate liability claims as it relates to trends.

22. Claims 9-12, 35 and 36 are rejected as being unpatentable over Beinat et al., US Patent No US 7,337,121 B1 in view of National Underwriter, AIG tackles claims management, April 12, 1999, herein referred to as "AIG", in further view of DiRienzo US Patent No 7,346,768 B2, in further view of Larkin et al US Patent Application Publication No US2002/0069089 A1.

23. With respect to Claims 9 and 10,

Beinat, AIG, and DiRienzo disclose all of the above limitations, DiRienzo further discloses,

- *the tangible medium is a paper or electronic form* (see at least column 1, lines 43-46: "...the present invention relates to an AIC system for preparing and processing digital insurance

claims including Prior Approval Claim (PAC) Applications containing both a text form and an integrated digitized attachment…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat and the Integrated Disability Management (IDM), claims management strategies of AIG with the Attachment Integrated Claim (AIC) application system of DiRienzo because this would minimize the amount of user input and/or error enterred into the claim form while providing a consistent template for claims assessment. It is old and well known in the art of the health care industry for insurance companies to use paper and/or electronic forms when filling out insurance claims. Computerization to include electronic filing is a highly effective way of reducing administrative overhead in claims processing.

Beinat, AIG and DiRienzo disclose all of the above limitations. The combination of Beinat, AIG, and DiRienzo does not disclose the following limitations, but Larkin as shown discloses,

- *the primarily prominent portion is the first or front page of the form and the secondarily prominent portion is the second or back page of the form.* (see at least Figure 9, paragraph 34: "…FIG. 9 shows an exemplary C-9 physicians report/treatment plan report in accordance with one embodiment of the invention.."; paragraph 45: "…In the Internet embodiment, this questionnaire is preferably an electronic questionnaire in the form of one or more Internet web pages which are electronically filled out by the user 6. In a preferred embodiment, the questionnaire includes sections on the symptoms 24, physical findings 26, mechanism of injury 28, and diagnostic tests 30, as these data are typically useful in making a medical diagnosis…"; paragraph 67: "…The URAC case tracking information recorded using the case management tracking method of FIG. 10 is preferably used by the report generator 90 to display the URAC reports 96, 98A, 98B, 98C indicated in FIG. 4…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat and the Integrated Disability Management (IDM), claims management strategies of AIG with the Attachment Integrated Claim (AIC) application

system of DiRienzo because this would minimize the amount of user input and/or error entered into the claim form while providing a consistent template for claims assessment. It is old and well known in the art of the health care industry for insurance companies to use paper and/or electronic forms when filling out insurance claims. Computerization to include electronic filing is a highly effective way of reducing administrative overhead in claims processing.

24. With respect to Claims 11 and 12,

Beinat, AIG, DiRienzo, and Larkin disclose all of the above limitations. Larkin further discloses:

- *wherein the primarily prominent portion contains five categories.* (see at least paragraph 64: "...With reference now to FIG. 10, a preferred interfacing with the regulatory record-keeping aspect of the invention in accordance with the URAC standards is described. The user selects the case management tracking option, which is preferably a URAC compliant tracking system, in a step 300. The previously entered information for each injured person is displayed 301 in a step 302. The displayed information is preferably divided into URAC-defined categories that in the exemplary embodiment of FIG. 10 include: "Provider of Record", "Initial Treatment Information", "Diagnoses", "Work Status", "Job Description/Title", "Medical History", "Injury Description", "Case Management Criteria", Case Management Relationship", "TPA Disclosure", "Written Notification of Actions/Recommendations", "Complaint Process", "Client Selection Rationale", "Anticipated Case Results", "Short Term Goals", "Long Term Goals", "Current Treatment Information", "Referrals", "Resources/Collaborative Approaches", and "Case Closure". Of course, more, fewer, or different categories can be included in the case management tracking system...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat, the Integrated Disability Management (IDM), claims management strategies of AIG, the Attachment Integrated Claim (AIC) application system of DiRienzo, and the case management system (report generator) of Larkin because this would

provide consistent and complete paperwork for regulatory agencies, medical personnel, etc… while monitoring compliance as it relates to the URAC standards.

25. With respect to Claims 35 and 36,

Bienet, AIG and DiRienzo disclose all of the above limitations, AIG further discloses:

determining, from the number of categories found to apply, whether the claim should be referred to a higher review level, automatically or with qualification, (see at least paragraph 4: "…IDM uses a telephonic case management system that profiles incoming claims and enables case managers to identify those most in need of case management. This helps reduce lost days and achieves optimum medical outcomes…"; paragraph 9: "…the IDM program uses a single-source 800 number to report claims, a single customer service and medical management team, single dispute resolution, and cross-and duplicate-claims monitoring…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat with the Integrated Disability Management (IDM), claims management strategies of AIG because this would help provide early intervention, thereby minimizing costs and provide real-time claims information. This would offer an improved process for efficiently and consistently evaluating liability insurance claims.

Bienet, AIG and DiRienzo disclose all of the above limitations; the combination of Bienet, AIG and DiRenzo does not disclose the following, but Larkin however as shown discloses,

- *on the primarily prominent portion of the form.* (see at least Figure 9, paragraph 34: "…FIG. 9 shows an exemplary C-9 physicians report/treatment plan report in accordance with one embodiment of the invention…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat, the Integrated Disability Management (IDM), claims management strategies of AIG, the Attachment Integrated Claim (AIC) application system

of DiRienzo, and the case management system (report generator) of Larkin because this would provide consistent and complete paperwork for regulatory agencies, medical personnel, etc… while monitoring compliance as it relates to the URAC standards.

26. Claims 13-16, 19, 20, 23, 24, 26, 28, 30, and 32 are rejected as being unpatentable over Beinat et al., US Patent No US 7,337,121 B1 in view of National Underwriter, AIG tackles claims management, April 12, 1999, herein referred to as "AIG", in further view of DiRienzo US Patent No 7,346,768 B2, in further view of Larkin et al US Patent Application Publication No US2002/0069089 A1, in further view of Crivella et al., US Patent Application Publication No US 2006/0282468 A1.

27. With respect to Claims 13-16, 19, 20, 23, and 24

Bienet, AIG, DiRienzo, and Larkin disclose all of the above limitations. The combination of Bienet, AIG, DiRienzo, and Larkin does not disclose the following limitations, but Crivella however as shown discloses,

- *each category also contains associated with it one or more selectable data entries which relate to bases for finding the category applicable.*. (see at least Figure 3c, paragraph 19: "…allows the information to be included within categories each having subcategories that together implement the database schema. The information in each category or subcategory is retrievable independent of the information in any other category or subcategory, and information containing a common characteristic is retrievable from different categories or subcategories…")

- *the five categories in the primarily prominent portion are: 1) Preliminary Analysis Suggests Denial; 2) Mixed Suit - Covered and/or Potentially Covered with Uncovered Claims; 3) Key Policyholder Counsel Tenders Claim for Defense or Independent/Cumis Counsel Involved; 4) Misrepresentation or Omission in Application and/or Pre-existing Loss Suspected; and one of*

the following: 5) Umbrella/Excess Coverage by Company, 6) Defense Tendered by Other than Named Insured, 7) Latent and/or Continuous and Progressive Injury or Damage, 8) Other Carriers Involved, or 9) Target Claims/Damages Alleged.

- *the secondarily prominent portion contains the other categories 5) to 9) not on the primarily prominent portion plus the following categories: 10) Internet-Related Liability Issues, 11) Potential Personal Injury or Advertising Injury, 12) Insolvent Insurer and/or Guaranty Fund Involved or On Notice, 13) SIR of $100,000 or More, and 14) Employment-Related Claims.*
- *the instructions for determining whether the claim should be referred to a higher review level are whether three of the five categories in the primarily prominent portion are found applicable and, optionally, the instructions for determining whether the claim should be referred to a higher review level upon qualification are whether seven of a total of 14 categories in the total form are found applicable.*

(see at least Figure 3C, paragraph 19: "…The database schema provides multiple levels of restricted access to the managed information in a way that allows the information to be included within categories each having subcategories that together implement the database schema. The information in each category or subcategory is retrievable independent of the information in any other category or subcategory, and information containing a common characteristic is retrievable from different categories or subcategories. The database schema is structured to allow a single item of managed information to be stored in at least two different locations when that information has been altered from its original form, and a single item of managed information can be referred to by more than one designation in a way that permits each designation to reference other designations for that item…"; paragraph 29: "…FIG. (3C) shows an example of a page revealing predefined categories of information pertaining to a particular element, and shows the library of files and functionalities accessible from the page or related to the element…"; paragraph 66: "…The database schema implements the library science approach for uniform categorization of the various types information used in the knowledge management performed by the system….Searching of the

database schema can be done by any standard search scheme such as natural language and Boolean operator searches…"; Figure 5, paragraph 67: "…An example database schema for implementing the present invention in a litigation support context entitled "Categories of a Litigation Knowledge Kiosk Elements--Overview" is shown in FIG. (5). The "pie-chart" organization of the schema represents the entire universe of information included in that particular Knowledge Kiosk. Upon receipt by the system, the digitized data (or Knowledge Element) to be included in the Knowledge Kiosk is categorized for storage in the "library" according to the database schema organizational concept developed for the client, and is retrieved from the "library" using the graphical user interface (GUI) navigation scheme provided by the website interface to access the data according to its stored category type(s). Each Knowledge Kiosk designed for a different application or use requires a different database schema "library" structure, which is dictated by the business processes and practices that are undertaken by the client in gathering and using the information contained in the Knowledge Kiosk…"; paragraph 72: "…In another example, the "pie" or category is established to include all insurance policies having a certain commonality such as being based on a particular Insurance Services Office (ISO) form issued in a particular year. The system recognizes this layer of the pie or category as a relationship shared by the policies….")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat, the Integrated Disability Management (IDM), claims management strategies of AIG, the Attachment Integrated Claim (AIC) application system of DiRienzo, the case management system (report generator) of Larkin with the database library schema of Crivella because this would provide uniform categorization of the various types information used in the knowledge management performed by the system. The database could be implemented by any standard internet (or web) accessible database that is structured query language (SQL) compliant . Since the database is developed based on

the client's needs, it represents how the "library" is organized to categorize the particular types of information managed by the client's Knowledge Kiosk. The would provide an efficient means for consistent and complete paperwork for regulatory agencies, medical personnel, etc... while monitoring compliance as it relates to the URAC standards.

While Crivella does not specifically disclose "the five categories in the primarily prominent portion", Crivella does disclose a database schema which implements the library science approach for uniform categorization of the various types information used in the knowledge management performed by the system. It represents how the "library" is organized to categorize the particular types of information managed by the client's Knowledge Kiosk.

Claims 13-16, 19, 20, 23, 24, 26, 28, 30, and 32 refer to non-functional descriptive material, "categories", and thus is not given patentable weight because it is not further limiting. (see MPEP 2106.01).

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the

medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and >In re Warmerdam, 33 F.3d *>1354, 1360-61, 31 USPQ2d *>1754, 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., an abstract idea, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See >Diamond v. Diehr, 450 U.S. *>175, 185-86, 209 USPQ *>1, 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "the sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("Each invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.") (Quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under the copyright law.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory and should be rejected under 35 U.S.C. 101. In addition, USPTO personnel should inquire whether there should be a rejection under 35 U.S.C. 102 or 103. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384, 217 USPQ at 403; see also Diehr, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See *In re* Lowry, 32 F.3d 1579 1583-84, 32 USPQ2d 1031, 1035(Fed. Cir. 1994) In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 1863-1864 (Fed. Cir. 2004).

28. With respect to Claim 26,

Bienet, AIG and DiRienzo disclose all of the above limitations, DiRienzo further discloses:

- *whether the claim should be referred to a higher review level are based on a weighting system whereby each category is assigned a particular weighting and a certain threshold of the sum of weightings of the total categories or a sub-set of categories found applicable is met.*

  (see at least Figure 18, Table 20, column 52, lines 16-25: "...Determining the percentage of the total severity contributed by each body part, the arm, left elbow and left forearm contribute, in decimal format, 0.004, 0.523 and 0.473, respectively, of the whole. Each body part's contribution to the total severity is projected onto its position vector as defined by its coordinates. That is, the X, Y and Z components for each body part are multiplied by the body part's severity contribution, resulting in the weighted body part coordinates...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat and the Integrated Disability Management (IDM), claims management strategies of AIG with the Attachment Integrated Claim (AIC) application system of DiRienzo because this would allow the insurance company to more efficiently evaluate liability claims.

29. With respect to Claims 28, and 32

Bienet, AIG, DiRienzo, and Larkin disclose all of the above limitations, AIG further discloses:

- *number of categories found to apply, whether the claim should be referred to a higher review level are executed by a computer*
- *claim should be referred to a higher review level are executed by a computer* (see at least paragraph 4: "…IDM uses a telephonic case management system that profiles incoming claims and enables case managers to identify those most in need of case management. This helps reduce lost days and achieves optimum medical outcomes…"; paragraph 9: "…the IDM program uses a single-source 800 number to report claims, a single customer service and medical management team, single dispute resolution, and cross-and duplicate-claims monitoring…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat with the Integrated Disability Management (IDM), claims management strategies of AIG because this would help provide early intervention, thereby minimizing costs and provide real-time claims information. This would offer a more efficient process for management of liability insurance claims.

30. Claims 17, 18, 21, and 22 are rejected as being unpatentable over Beinat et al., US Patent No US 7,337,121 B1 in view of National Underwriter, AIG tackles claims management, April 12, 1999, herein referred to as "AIG", in further view of Crivella et al., US Patent Application Publication No US 2006/0282468 A1.

31. With respect to Claims 17 and 18,

Beinat, and AIG disclose all of the above limitations, Beinat and AIG does not disclose the following, but Crivella howeverr as shown discloses,

- *at least one category also contains associated with it one or more selectable data entries which relate to bases for finding the category applicable.* (see at least Figure 3c, paragraph 19: "…allows the information to be included within categories each having subcategories that together implement the database schema. The information in each category or subcategory is retrievable independent of the information in any other category or subcategory, and information containing a common characteristic is retrievable from different categories or subcategories…")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat with the Integrated Disability Management (IDM), claims management strategies of AIG with the classified knowledge kiosk system of Crivella because these features would prove an improved process for managing liability insurance claims.

32. With respect to Claims 21 and 22,

Beinat, and AIG disclose all of the above limitations, Beinat and AIG does not disclose the following, but Crivella however as shown discloses,

- *the instructions for determining whether the claim should be referred to a higher review level are based on whether a number, n, of categories out of the total categories or a selected sub-set of categories are found applicable* (see at least paragraph 29: "…shows an example of a page revealing predefined categories of information pertaining to a particular element…"; Figure 5, paragraph 73: "…The same principles apply as described above with respect to FIG. (5) in terms of "cutting" the cake "vertically" to access all documents of a given category no matter what case they relate to; "cutting" the cake "horizontally" to access all documents from a given case no matter what category they relate to; or "cutting" the cake both "vertically" and "horizontally" to access only those documents included in a particular

category that relate to a given case and/or also have a certain characteristic in common.."; paragraph 92: "... the system provides a messaging workstation as shown in FIGS. (26) and (26A). The messaging workstation allows both users and the system to exchange priority information. There are system-generated alerts, which escalate messages to users and management, for example, stating policy review standards are in danger of failing to meet required deadlines. The auto notifications are sent to both the Kiosk's internal messaging system and the user's desktop email.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the claim assessment model of Beinat with the Integrated Disability Management (IDM), claims management strategies of AIG with the classified knowledge kiosk system of Crivella because these features would all users to share and communicate important information expeditiously.

Conclusion

33. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812.**

34. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center

(EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/ Examiner, Art Unit 3629

October 1, 2008

/John G. Weiss/

Supervisory Patent Examiner, Art Unit 3629